

JUDGMENT OF THE GENERAL COURT (First Chamber)

5 July 2016 (*)

(European Union trade mark — Invalidity proceedings — European Union word mark MACCOFFEE — Earlier European Union word mark McDONALD'S — Article 53(1)(a) and Article 8(5) of Regulation (EC) No 207/2009 — Family of marks — Taking unfair advantage of the distinctive character or repute of the earlier mark — Declaration of invalidity)

In Case T-518/13,

Future Enterprises Pte Ltd, established in Singapore (Singapore), represented initially by B. Hitchens, J. Olsen, R. Sharma, M. Henshall, Solicitors, and R. Tritton, Barrister, and subsequently by B. Hitchens, J. Olsen, R. Tritton and E. Hughes-Jones, Solicitor,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by L. Rampini, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being:

McDonald's International Property Co. Ltd, established in Wilmington, Delaware (United States), represented by C. Eckhardt, lawyer,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 13 June 2013 (Case R 1178/2012-1) relating to cancellation proceedings between McDonald's International Property Co. and Future Enterprises,

THE GENERAL COURT (First Chamber),

composed of H. Kanninen, President, I. Pelikánová (Rapporteur) and E. Buttigieg, Judges,

Registrar: A. Lamote, Administrator,

having regard to the application lodged at the Court Registry on 23 September 2013,

having regard to the statements in response of EUIPO and the intervener lodged at the Court Registry on 22 January 2014,

having regard to the reply lodged at the Court Registry on 1 July 2014,

having regard to the rejoinder of the intervener lodged at the Court Registry on 24 November 2014,

further to the hearing on 2 February 2016,

gives the following

Judgment

Background to the dispute

1 On 13 October 2008, the applicant, Future Enterprises Pte Ltd, filed an application for registration of a European Union trade mark at the European Union Intellectual Property Office (EUIPO), in accordance with Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1)).

2 The trade mark in respect of which registration was sought is the word sign MACCOFFEE.

3 The goods in respect of which registration was sought are in Classes 29, 30 and 32 of the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

– Class 29: ‘Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; dairy products; cream (dairy products); whipped cream; preparations for use in creaming beverages (dairy based); dairy puddings; yoghurt; foodstuffs in the form of snack foods; fruit-based snack foods; potato-based snack foods; potato crisps in the form of snack foods; beverages made from or containing milk; milk shakes’;

– Class 30: ‘Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; cookies; breakfast cereal; frozen confections; crackers; frozen yoghurt; ice cream; pretzels; confectionery chips; sugar confectionery; candy; candy bars; candy mints; chocolate; chocolate confectionery; cakes; muffins; popcorn; cereal based snack foods; prepared savoury foodstuffs in the form of snack foods; corn chips; tortillas; pastries; bread; filled sandwiches; wraps (sandwiches); toasted sandwiches; dessert puddings; instant coffee; instant coffee mix; coffee beans; coffee in ground form; iced coffee; coffee beverages with milk; cocoa beverages with milk, chocolate-based beverages, coffee and coffee-based beverages, cocoa and cocoa-based beverages; tea-based beverages; tea, namely, ginseng tea, black tea, oolong tea, barley and barley-leaf tea; fruit teas; herbal tea (other than for medicinal use); iced tea’;

– Class 32: ‘Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; fruit-based soft drinks flavoured with tea or coffee (not included in other classes); non-alcoholic beverages with tea or coffee flavour (not included in other classes)’.

4 The European Union trade mark application was published in *Community Trade Marks Bulletin* No 1/2009 of 12 January 2009 and the word sign MACCOFFEE was registered as a European Union trade mark on 29 January 2010 under No 7307382 for all the goods listed in paragraph 3 above.

5 On 13 August 2010, the intervener, McDonald's International Property Co. Ltd, brought an application for a declaration of invalidity of the contested trade mark, for all of the goods in respect of which that trade mark had been registered.

6 The application for a declaration of invalidity was based on the following earlier trade marks:

- European Union word mark McDONALD'S, lodged on 1 April 1996 and registered on 16 July 1999 under No 62 497, for the goods and services in classes 29, 30, 32 and 42;
- European Union word mark McFISH, lodged on 18 April 2006 and registered on 20 July 2007 under No 5 056 429, for the goods in classes 29 and 30;
- European Union word mark McTOAST, lodged on 24 October 2005 and registered on 20 April 2007 under No 4 699 054, for the goods and services in classes 29, 30 and 43;
- European Union word mark McMUFFIN, lodged on 27 July 2005 and registered on 7 August 2006 under No 4 562 419, for the goods and services in classes 29, 30 and 43;
- European Union word mark McRIB, lodged on 19 November 1999 and registered on 11 June 2001 under No 1 391 663, for the goods in classes 29 and 30;
- European Union word mark McFLURRY, lodged on 30 June 1998 and registered on 8 September 1999 under No 864 694, for the goods in class 29;
- European Union word mark CHICKEN McNUGGETS, lodged on 1 April 1996 and registered on 4 August 1998 under No 16 196, for the goods in class 29;
- European Union word mark McCHICKEN, lodged on 1 April 1996 and registered on 2 February 1998 under No 16 188, for the goods in class 30;
- European Union word mark EGG McMUFFIN, lodged on 1 April 1996 and registered on 19 December 1997 under No 15 966, for the goods in class 30;
- European Union word mark McFEAST, lodged on 1 April 1996 and registered on 27 October 1999 under No 15 941, for the goods in class 30;
- European Union word mark BIG MAC, lodged on 1 April 1996 and registered on 22 December 1998 under No 62 638, for the goods and services in classes 29, 30 and 42;
- European Union word mark PITAMAC, lodged on 1 February 2005 and registered on 11 April 2006 under No 4 264 818, for the goods and services in classes 29, 30 and 42;
- the well-known German trademark McDonald's, for the goods and services in classes 29, 30, 32 and 43.

7 The grounds relied on by the intervener were those referred to in Article 53(1)(a) of Regulation No 207/2009, read in conjunction with Article 8(1)(a) and (b), Article 8(2)(c) and Article 8(5) of that Regulation.

8 At the request of the applicant, proprietor of the contested trade mark, the intervener was asked to furnish proof of genuine use of the earlier trade marks on which the intervener based its application, in accordance with Article 57(2) and (3) of Regulation No 207/2009.

9 By decision of 27 April 2012, the Cancellation Division declared the contested trade mark to be invalid in its entirety, pursuant to Article 53(1)(a) of Regulation No 207/2009, read in conjunction with Article 8(5) of that regulation, and it did so solely on the basis of the earlier European Union word mark McDONALD'S, registered under No 62 497, on the ground that, given the long-standing reputation acquired by the McDONALD'S trade mark and the establishment, on the part of the relevant public, of a link between that and the contested trade mark, there was a serious likelihood that use, without due cause, of the contested trade mark would take unfair advantage of the reputation of the McDONALD'S trade mark.

10 On 26 June 2012, the applicant filed an appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the decision of the Cancellation Division.

11 By decision of 13 June 2013 ('the contested decision'), the First Board of Appeal of EUIPO dismissed the applicant's appeal in its entirety, concurring, in essence, with the Cancellation Division's argument that all the conditions for the application of Article 8(5) of Regulation No 207/2009 were, in the present case, fulfilled. In that regard, it noted that the McDONALD'S trade mark enjoyed a considerable reputation for fast-food restaurant services. In the context of the relevant factors that make it possible to assess whether the relevant public, namely the general public within the European Union, who also made use of the intervener's fast-food restaurant services, could establish a link between the trade marks at issue, the Board of Appeal found (i) that the trade marks at issue were similar, (ii) that the considerable reputation acquired by the McDONALD'S trade mark also extended to the combination of the prefix 'mc' with the name of a menu item or foodstuff, (iii) that the intervener was the proprietor of a family of trade marks, which combined the prefix 'mc' with the name of a menu item or foodstuff ('the "Mc" family of trade marks'), (iv) that the contested trade mark reproduced the structure common to the 'Mc' family of trademarks and (v) that the services and goods covered by the trade marks at issue had a certain degree of similarity owing to the close links existing between them. After assessing all of those factors, the Board of Appeal came to the conclusion that the relevant public could mentally establish a link between the conflicting trade marks and even, for a large part of that public, associate the contested trade mark with the 'Mc' family of trade marks. In the view of the Board of Appeal, the establishment of such a link, on the part of the relevant public, could entail a transfer of the image of the McDONALD'S trade mark or the characteristics associated with that trade mark to the goods covered by the contested trade mark, such that it was highly probable that the applicant took unfair advantage of the reputation of the McDONALD'S trade mark. Lastly, the Board of Appeal noted that the use of the contested trade mark was without due cause.

Forms of order sought

12 The applicant claims, in essence, that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs.

13 EUIPO and the intervener contend that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

Preliminary remarks on the legal framework and the subject-matter of the proceedings

14 Pursuant to Article 53(1)(a) of Regulation No 207/2009, a European Union trade mark is to be declared invalid, on application to EUIPO, inter alia where there is an earlier trade mark, within the meaning of Article 8(2) of that regulation, namely a trade mark with a date of application for registration which is earlier than that of the European Union trade mark whose cancellation is sought, and the conditions set out in Article 8(5) of that regulation are fulfilled. It follows from that provision that the cancellation of a European Union trade mark may be requested even if that mark was registered for goods or services which are not similar to those for which the earlier mark was registered.

15 For an earlier trade mark to be afforded that broader protection under Article 8(5) of Regulation No 207/2009, a number of conditions must be satisfied. First, the earlier European Union trade mark must have been lodged before that for which cancellation is sought and must be registered. Second, the earlier European Union trade mark and that for which cancellation is sought must be identical or similar. Third, the earlier European Union trade mark must have a reputation in the European Union. Fourth, the use without due cause of the European Union trade mark for which cancellation is sought must lead to the risk that unfair advantage might be taken of the distinctive character or the repute of the earlier European Union trade mark or that it might be detrimental to the distinctive character or the repute of that trade mark. As those conditions are cumulative, failure to satisfy one of them is sufficient to render Article 8(5) of Regulation No 207/2009 inapplicable (see judgment of 6 July 2012 in *Jackson International v OHIM — Royal Shakespeare (ROYAL SHAKESPEARE)*, T-60/10, not published, paragraph 18 and the case-law cited).

16 In the present case, the applicant does not contest either that the McDONALD'S trade mark was lodged before the contested mark, on 1 April 1996, and registered on 16 July 1999 (see paragraph 6 above), or that the McDONALD'S trade mark enjoys, in the European Union, a considerable reputation for fast-food restaurant services, so that compliance with the first and third conditions of application of Article 8(5) of Regulation No 207/2009, cited in paragraph 15 above, is not in issue.

17 However, the applicant disputes certain assessments which led the Board of Appeal, in the contested decision, to find that there was a certain degree of similarity between the marks at issue. According to the applicant, in view of (i) that similarity, (ii) the existence of the 'Mc' family of trade marks, (iii) the distinctive character acquired by the prefix 'mc', (iv) the considerable reputation enjoyed by the McDONALD'S trade mark, which extends to the prefix 'mc', used in combination with the name of a menu item or a foodstuff, and (v) a certain degree of similarity between the goods and services covered by the marks at issue, because of the close links between them, such a link could be established, by the relevant public, between the marks at issue. Consequently, it is highly probable, it is claimed, that the use without due cause of the contested trade mark takes unfair advantage of the reputation of the McDONALD'S trade mark. The subject matter of the proceedings is therefore limited to the question of whether the Board of Appeal was entitled to confirm, in the contested decision, the assessments of the Cancellation Division according to which the second and fourth conditions for the application of Article 8(5) of Regulation No 207/2009, referred to in paragraph 15 above, were satisfied in the present case.

On whether there is a certain degree of similarity between the marks at issue

18 The applicant claims that the Board of Appeal made an error of assessment, in the contested decision, by concluding that the trade marks at issue were similar overall, to a certain degree. It argues that, in accordance with the case-law, the visual similarity must prevail in the present case, in so far as foodstuffs and beverages are selected, first and foremost, visually. According to the applicant, the marks at issue are visually very different and the Board of Appeal found, wrongly, that the elements ‘mac’ and ‘mc’ were visually similar. It also argues that, phonetically, the marks at issue are very different. The prefixes ‘mac’ and ‘mc’ are not, it claims, pronounced in the same way. In English, the use of a double ‘c’ means that the contested trade mark is pronounced ‘mac coffi’, while the McDONALD’S trade mark, it is claimed, is pronounced ‘me don alds’, and that, as is clear from the English case-law placed on the file of the present proceedings, the accent is on the second syllable ‘don’, which means that, phonetically, the element ‘mc’ is a secondary element. Conceptually, the applicant argues that the McDONALD’S trade mark is understood as a surname, while the contested trade mark, although it contains the element ‘mac’, which is also a common prefix in surnames of Gaelic origin (Scottish and Irish), is not broadly speaking understood to be a such a name, in so far as that element is associated with the term ‘coffee’, which is understood as referring to coffee, namely an aromatic hot beverage. In that context, the element ‘mac’ in the contested trade mark is probably understood as referring to an American slang word used to address a stranger in a friendly manner, as in the phrase ‘Hey Mac, you want a coffee?’ In the absence of any similarity between the trade marks at issue, the applicant considers that the Board of Appeal should have dismissed the application for a declaration of invalidity and observes that, even if those trade marks are slightly similar, that does not make it possible, in the light of EUIPO’s practice, to arrive at a finding that the relevant public will establish a link between them.

19 EUIPO and the intervener dispute the applicant’s arguments and contend that the complaints put forward by it should be rejected, on the ground that the Board of Appeal did not commit any error of assessment, in the contested decision, by concluding that there was a certain degree of overall similarity between the trade marks at issue.

20 In that regard, it should be pointed out that the protection provided by Article 8(5) of Regulation No 207/2009 is not conditional on there being a degree of similarity between the marks at issue, such that there exists, on the part of the relevant public, a likelihood of confusion between them. It is sufficient for the degree of similarity between those marks to have the effect that the relevant public establishes a link between them (see, by analogy, judgments of 16 May 2007 in *La Perla v OHIM — Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, T-137/05, not published, EU:T:2007:142, paragraph 34 and the case-law cited, and of 16 December 2010 in *Rubinstein and L’Oréal v OHIM — Allergan (BOTOLIST)*, not published, T-345/08 and T-357/08, EU:T:2010:529, paragraph 65 and the case-law cited).

21 The existence of such a degree of similarity, like the existence of a degree of similarity within the meaning of Article 8(1)(b) of Regulation No 207/2009, must be assessed globally, taking into account all factors relevant to the circumstances of the case. Accordingly, that global assessment must be based, in so far as the visual, phonetic and conceptual similarity of the marks at issue are concerned, on the overall impression given by the marks, account being taken, inter alia, of their distinctive and dominant elements (see, by analogy, judgment of 16 May 2007 in *NIMEI LA PERLA MODERN CLASSIC*, T-137/05, not published, EU:T:2007:142, paragraph 35 and the case-law cited).

22 In the present case, the absence of a likelihood of confusion between the marks at issue is not contested. The dispute therefore centres on the issue of whether the assessments of the Board of Appeal, in the contested decision, make it possible to find that the condition relating to the existence

of a minimal degree of similarity between the marks at issue, set out in Article 8(5) of Regulation No 207/2009, was fulfilled.

23 As regards, first, the visual similarity of the marks at issue, it should be noted that those marks are word marks.

24 As the applicant rightly points out, the marks at issue have substantial visual differences, in so far as, whereas the McDONALD'S mark consists of nine letters and a typographical sign and the contested mark consists of nine letters, they only have four letters in common, namely 'm', 'c', 'o' and 'a', three of which do not occupy the same position in the marks at issue. It is true that both of those marks start with the letter 'm' and their letters 'c' and 'o' are located respectively in the second and fourth positions in the McDONALD'S trade mark and in third and fifth positions in the contested mark. In addition, the letters 'm' and 'c' are included in the initial part of the marks at issue, namely the 'mac' and 'mc' elements. Further, a dissimilarity between the marks at issue cannot be deduced from the use of lower or upper case letters, because such a circumstance is immaterial, as the protection arising from the registration of a word mark relates to the word indicated in the application for registration and not to the particular graphic or stylistic aspects that that mark might possibly assume (see judgment of 29 April 2015, *Chair Entertainment Group v OHIM — Libelle (SHADOW COMPLEX)*, T-717/13, not published, EU:T:2015:242, paragraph 50 and the case-law cited). However, those findings are not sufficient to conclude that there is a visual similarity, even to a low degree, of the marks at issue.

25 The applicant is therefore correct to claim that the finding that the marks at issue were visually similar, to a low degree, which the Board of Appeal made in the paragraph 38 of the contested decision, is erroneous.

26 Next, with regard to the phonetic similarity of the marks at issue, it is necessary to confirm the assessment of the Board of Appeal, in paragraph 39 of the contested decision, that the initial parts of those marks, namely the elements 'mac' and 'mc' are both pronounced 'mak' or 'mac', the letter 'a' being a 'schwa' or murmured vowel, pronounced as in English word 'ago', at least by a part of the relevant public. It is true that certain items of evidence placed on the file in the present proceedings may cast doubt on the merits of the assessment thus made by the Board of Appeal when it clearly referred to the English-speaking part of that public. It follows from the second sentence of paragraph 44 of the judgment of the High Court of Justice (England & Wales), Chancery Division (United Kingdom) of 27 November 2001, in the case of *Frank Yu Kwan Yuen v McDonald's*, submitted by the applicant, that 'the first syllable of McCHINA ... is pronounced slightly differently from MAC'. Accordingly, it seems that all or part of the relevant English-speaking public would pronounce the initial part of the marks at issue slightly differently. However, such an error, if it exists, would not affect the legality of the contested decision, to the extent that, as EUIPO rightly points out, the part of the public that perceives the prefixes 'mc' and 'mac' as prefixes of Gaelic surnames pronounces them in the same way. Those prefixes are traditionally pronounced the same way, namely 'mac' (see, to that effect, judgments of 5 July 2012 in *Comercial Losan v OHIM — McDonald's International Property (Mc. Baby)*, T-466/09, not published, EU:T:2012:346, paragraphs 37 and 41, and of 26 March 2015, *Emsibeth v OHIM — Peek & Cloppenburg (Nael)*, T-596/13, not published, EU:T:2015:193, paragraphs 48 and 50).

27 Moreover, even assuming, as the applicant contends, that all or part of the relevant public fully pronounce the vowel 'a', in the initial part of the contested mark, while it murmurs that vowel in the initial part of the McDONALD'S mark, the fact remains that the pronunciations of the initial parts of the marks at issue are highly similar. It is true that the final parts of those marks, namely the elements 'donald's' and 'coffee', are phonetically different, since the mere fact that one letter in

them, namely the letter ‘o’, is pronounced in the same way is, in that regard, negligible. These differences, however, do not mean that there is not a certain overall phonetic similarity between those marks, resulting from their identical or, at the very least, highly similar pronunciation of their initial part, namely the ‘mac’ and ‘mc’ elements, by the relevant public.

28 The Board of Appeal was therefore right to find, in paragraph 41 of the contested decision, that the marks at issue were phonetically similar, to a certain degree.

29 As regards the conceptual similarity of the marks at issue, it should be recalled that, according to case-law, marks are fairly similar when they evoke the same idea (see, to that effect, judgments of 16 May 2007 in *Merant v OHIM — Focus Magazin verlag (FOCUS)*, T-491/04, not published, EU:T:2007:141, paragraph 57, and of 11 December 2008 in *Tomorrow Focus v OHIM — Information Builders (Tomorrow Focus)*, T-90/06, not published, EU:T:2008:567, paragraph 35).

30 In the present case, first of all, it should be noted, as the Board of Appeal did in paragraphs 42 and 66 of the contested decision, that the elements ‘mc’ and ‘mac’ in the marks at issue are associated, by the relevant public, with the same idea, namely the prefix of a Gaelic surname, which the English-speaking part of the relevant public even identifies as meaning ‘son of’, and which carries no particular meaning for the rest of the relevant public (see, to that effect, judgment of 5 July 2012 in *Mc. Baby*, T-466/09, not published, EU:T:2012:346, paragraph 41, and of 26 March 2015 in *Nael*, T-596/13, not published, EU:T:2015:193, paragraph 41). As EUIPO correctly observes, it is common knowledge, for the part of the relevant public that knows the prefixes of Gaelic surnames, that they are written interchangeably as ‘mc’ or ‘mac’. Furthermore, the Board of Appeal was right to find, at least for the English-speaking part of the relevant public, that the final part of the contested mark, namely the element ‘coffee’, was understood as making reference to an aromatic drink, traditionally served hot, blended from the beans of the coffee plant. The part of the relevant public that knows the prefixes of Gaelic surnames and that understands the meaning of the English word ‘coffee’ is able to identify, in the contested mark, the association of those two elements, and particularly since, as EUIPO rightly points out, such an association of the prefix ‘mac’ or ‘mc’ with a word used in everyday language is not unusual (judgment of 5 July 2012, *Mc. Baby*, T-466/09, not published, EU:T:2012:346). The association, in the contested mark, of a word referring to a Gaelic surname and of another word referring to the name of a drink is more probably understood by the relevant public as a reference to a beverage produced by a person of Scottish or Irish origin than, as the applicant submits, as referring to a familiar expression in which the word ‘mac’ is used as a friendly address to a stranger.

31 It follows from the above that the marks at issue have a certain conceptual similarity, in so far as they are both perceived, at least by a part of the relevant public, as referring to a surname of Gaelic origin. Consequently, the Board of Appeal was right to find, in paragraph 42 of the contested decision, that the marks at issue were conceptually similar, to a certain degree.

32 As regards, finally, the overall similarity existing between the marks at issue, which is sufficient for the relevant public to establish a link between them, even if it does not confuse them, it should be recalled that it must be determined taking into account the visual, phonetic and conceptual similarity of those marks and, if appropriate, the assessment of the relative importance that should be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see, to that effect and by analogy, concerning the assessment of the existence of a likelihood of confusion, judgment of 22 June 1999 in *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 27).

33 In the present case, the marks at issue differ visually, but have a certain degree of phonetic and conceptual similarity, which stems from their respective initial part, namely the ‘mac’ and ‘mc’ elements. Those phonetic and conceptual similarities between the marks cannot be totally disregarded on the ground, alleged by the applicant, that the method of marketing the goods covered by the trade mark concerned is based on a selection that is primarily visual. It is true that it follows from the case-law that, where the goods covered by a mark are everyday consumer goods, usually sold in self-service stores, the relevant public, when purchasing, usually perceives the mark concerned visually, so that the visual aspect is more important in the overall assessment of the similarity between that mark and another mark, with which it is in conflict (see, to that effect and by analogy, concerning the assessment of the existence of a likelihood of confusion, judgments of 23 May 2007, *Henkel v OHIM — SERCA (COR)*, T-342/05, not published, EU:T:2007:152, paragraph 53 and the case-law cited, and of 13 December 2007 in *Cabrera Sánchez v OHIM — Industrias Cárnicas Valle (el charcutero artesano)*, T-242/06, not published, EU:T:2007:391, paragraph 80 and the case-law cited). However, even if, in such a case, the phonetic similarity is of less importance (judgment of 13 December 2007, *el charcutero artesano*, T-242/06, not published, EU:T:2007:391, paragraph 81), in so far as the mark will usually not be pronounced by the consumer of the goods concerned, it does not thereby become negligible and indeed remains as important as ever, since it is not excluded that, in some cases, an oral communication concerning the goods and the mark concerned may have occurred prior to purchase (see, to that effect, judgments of 23 May 2007 in *COR*, T-342/05, not published, EU:T:2007:152, paragraph 53, and of 23 September 2011 in *NEC Display Solutions Europe v OHIM — C More Entertainment (see more)*, T-501/08, not published, EU:T:2011:527, paragraph 53) or that those goods have been advertised orally, on radio or by other consumers (judgment of 23 September 2011, *see more*, T-501/08, not published, EU:T:2011:527, paragraph 53). Similarly, while, in such a case, the importance of the conceptual similarity is reduced by the fact that, in self-service stores, consumers lose little time between successive purchases and often do not read all the information on the various products, letting themselves be guided more by the overall visual impression produced by the labels or packaging (judgment of 2 December 2008 in *Ebro Puleva v OHIM — Berenguel (BRILLO’S)*, T-275/07, not published, EU:T:2008:545, paragraph 24), it does not necessarily become insignificant, in particular where the marks at issue are word marks.

34 Taking phonetic and conceptual aspects into account, it can be concluded that, even if the marks at issue differ visually and also have conceptual and phonetic differences, because of their different final part, they nonetheless have a certain degree of overall similarity, due to the conceptual and phonetic similarity of their respective initial part, namely the elements ‘mc’ and ‘mac’.

35 Consequently, even if the Board of Appeal erred in deciding that the marks at issue had a low degree of visual similarity (see paragraph 25 above), it was right to find, in paragraph 48 of the contested decision, that the marks at issue were similar overall, to a certain degree. Accordingly, the error identified in the context of the assessment of the similarity between the marks at issue must not lead to the annulment of the contested decision.

36 It must therefore be held that the assessments of the Board of Appeal, in the contested decision, that the second condition for application of Article 8(5) of Regulation No 207/2009, referred to in paragraph 15 above, was satisfied in the present case are well founded and, therefore, all of the complaints regarding those assessments must be rejected.

On whether the relevant public will establish a link between the marks at issue

37 In the first place, it should be pointed out that the types of damage referred to in Article 8(5) of Regulation No 207/2009, where they occur, are the consequence of a connection that the relevant public makes between the marks at issue, that is to say, a link that it establishes between those marks, even though it does not confuse them (see, to that effect, judgment of 6 July 2012 in *ROYAL SHAKESPEARE*, T-60/10, not published, EU:T:2012:348, paragraph 19 and the case-law cited). The establishment of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see judgment of 6 July 2012 in *ROYAL SHAKESPEARE*, T-60/10, not published, EU:T:2012:348, paragraph 20 and the case-law cited). Those factors include the degree of similarity between the marks at issue, the nature of the goods or services covered by those marks, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public, the strength of the earlier mark's reputation, the degree of the earlier mark's distinctive character, whether inherent or acquired through use and the existence of a likelihood of confusion (see judgment of 6 July 2012, *ROYAL SHAKESPEARE*, T-60/10, not published, EU:T:2012:348, paragraph 21 and the case-law cited).

38 In the present case, the applicant contests, in particular, the findings of the Board of Appeal, in the contested decision, according to which, first, the existence of the family of marks 'Mc' is a relevant factor in assessing whether the relevant public establish a link between the marks at issue and, secondly, there is a certain degree of similarity between the services and goods in question, due to the close links existing between them.

On whether the existence of the family of trade marks 'Mc' is a relevant factor when assessing if the relevant public establish a link between the marks at issue

39 The applicant claims that the Board of Appeal made an error of assessment, in the contested decision, in concluding that, as a result of the element 'mac' in the contested mark, the relevant public could associate that trade mark with the 'Mc' family of trade marks, from the McDONALD'S trade mark. It considers, in that regard, that the case-law concerning the family of marks must be strictly interpreted, as it derogates from the general principle that any trade mark must be assessed globally. According to the applicant, the documents placed by the intervener on the case-file relating to the proceedings before EUIPO, namely menus from the intervener's fast-food restaurants, an independent survey carried out in 1991 and in 1992 and the decisions of courts of the Member States, were insufficient to conclude that the prefix 'mc' was associated, on the part of the relevant public, with foodstuffs and beverages. Except for a document referring to the McDONALD's trade mark, those documents all dated from 2010 and, therefore, after 13 October 2008, the date on which the application for registration of the contested trade mark was filed. Furthermore, it is claimed, the part of the independent survey carried out in 1991 reveals only that the persons surveyed would associate the prefix 'mc' with the McDONALD'S trade mark, while the part of that survey carried out in 1992, the results of which could have been distorted by a biased drafting of the question posed, only makes it possible to conclude that most of the persons surveyed knew that the prefix 'mc', combined with other words, was used in relation to fast-food or self-service restaurant services. According to the applicant, the Board of Appeal was not justified in suggesting that the conclusions of the independent survey continued to be relevant more than 16 years later, and that they were even more relevant. Lastly, the decisions of courts of the Member States examined by the Board of Appeal are not, it is claimed, convincing, since they are not binding on EUIPO and relate to specific situations. The applicant states that it is clear, by implication, from the case-law and from Part C, Section 2, Chapter 7, paragraph 2, p. 4 of the directives concerning proceedings before EUIPO ('the EUIPO directives') that the concept of a family of trade marks is not applicable in the present case, in so far as the element 'mac' in the contested trade mark is not identical to the element 'mc', common to the 'Mc' family of trade marks. The element 'coffee' in the contested trade mark and which refers to the name of a beverage,

differentiates that trade mark from the intervener's earlier trade marks combining the prefix 'mc' with the name of a menu item or a foodstuff, written principally in lower-case letters. The applicant relies on the fact that, within the European Union, the intervener does not sell beverages under a trade mark including the prefix 'mc'. According to the applicant, the differences which exist between the contested trade mark and the intervener's earlier trade marks are sufficiently significant to be perceived by the relevant public.

40 In the alternative, the applicant claims that the McDONALD'S trade mark does not have the same structure as the intervener's other earlier trade marks, combining the prefix 'mc' with the name of a menu item or a foodstuff, such that it does not belong to the 'Mc' family of trade marks. Use of the element 'mc' and, *a fortiori*, of the element 'mac' is not, it is claimed, open to criticism as it is a common prefix in Gaelic surnames and is used in numerous ways, without raising any objections.

41 EUIPO and the intervener contest the applicant's arguments and submit that the Board of Appeal rightly found, in the contested decision, that the existence of the 'Mc' family of trade marks was a factor to be taken into account when assessing whether the relevant public established a link between the trade marks at issue.

42 As has been observed in paragraph 37 above, the establishment, on the part of the public concerned, of a link between the trade marks at issue, must be assessed globally, taking into account all factors relevant to the circumstances of the case (see judgment of 6 July 2012 in *ROYAL SHAKESPEARE*, T-60/10, not published, EU:T:2012:348, paragraph 20 and the case-law cited). One of the relevant factors in that regard is the existence of a family of earlier marks (see, to that effect, judgment of 26 September 2012 in *IG Communications v OHIM — Citigroup and Citibank (CITIGATE)*, T-301/09, not published, EU:T:2012:473, paragraph 106). Where an application for a declaration of invalidity of a mark is based on the existence of several previous marks possessing common characteristics which make it possible for them to be regarded as part of a family, the establishment, on the part of the public concerned, of a link between the mark in respect of which a declaration of invalidity is sought, and the earlier marks may result from the fact that the former has characteristics capable of associating it with the family consisting of the latter (see, to that effect and by analogy, judgment of 13 September 2007 in *Il Ponte Finanziaria v OHIM*, C-234/06 P, EU:C:2007:514, paragraphs 62 and 63).

43 Several marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' when, inter alia, they reproduce in full the same distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of a single prefix or suffix taken from an original mark (judgment of 23 February 2006 in *Il Ponte Finanziaria v OHIM — Marine Enterprise Projects (BAINBRIDGE)*, T-194/03, EU:T:2006:65, paragraph 123). The proprietor of the earlier marks did not provide evidence that those marks are perceived by the relevant public as constituting a family (judgment of 25 November 2014 in *UniCredit v OHIM*, T-303/06 RENV and T-337/06 RENV, EU:T:2014:988, paragraphs 65 to 67).

44 However, the relevant public cannot be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family, to detect common characteristics in such a family and to establish a link between that family and another trade mark containing elements that are similar to those characteristics. Therefore, for the relevant public to establish a link between a trade mark in respect of which a declaration of invalidity is sought and a 'family' of earlier trade marks, the earlier marks forming part of that family must be present on the market (see, to that effect and by analogy, judgments of 13 September 2007 in *Il Ponte Finanziaria v OHIM*, C-234/06 P,

EU:C:2007:514, paragraph 64, and of 23 February 2006 in *BAINBRIDGE*, T-194/03, EU:T:2006:65, paragraph 126).

45 It is therefore for the proprietor of the earlier marks, which is applying to have the later European Union trade mark declared invalid, to provide evidence of the effective use of a sufficient number of those marks as to be capable of constituting a ‘family’ of marks and, therefore, of demonstrating that such a family exists for the purposes of assessing whether the relevant public establishes a link between the mark in respect of which a declaration of invalidity is sought and the earlier marks which make up that ‘family’ (see, to that effect and by analogy, judgments of 13 September 2007 in *Il Ponte Finanziaria v OHIM*, C-234/06 P, EU:C:2007:514, paragraphs 65 and 66, and of 23 February 2006 in *BAINBRIDGE*, T-194/03, EU:T:2006:65, paragraph 126) or even simply between the mark in respect of which a declaration of invalidity is sought and the earlier mark originating from that ‘family’.

46 In view of the case-law cited in paragraphs 42 to 45 above, it must be determined, first, whether the intervener has provided evidence of the actual use of a sufficient number of its earlier marks to constitute, having regard to their common characteristics, a ‘family’ of marks and, secondly, whether the contested mark contains elements that connect with characteristics common to that ‘family’.

– The actual use of a sufficient number of earlier marks to constitute a ‘family’ of marks

47 In paragraphs 57 and 86 of the contested decision, the Board of Appeal endorsed the findings of the Cancellation Division according to which the evidence provided by the intervener was sufficient to prove genuine use of the McDONALD’S mark for fast-food restaurant services. In that regard, it referred in particular to the evidence produced by the intervener that the mark occupied the sixth position in the world in the global analysis of trade marks carried out by a consultancy firm, and that the services sold under that mark generated an income of about EUR 32 billion, which was further supported by declarations, to which were appended product labels, menu displays and promotional material.

48 Furthermore, in paragraphs 58 to 60 of the contested decision, the Board of Appeal stated that the evidence provided by the intervener was sufficient for a finding of actual use on the market of marks combining the prefix ‘mc’ with another word, such as the marks McFISH, McTOAST, McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN, EGG McMUFFIN and McFEAST, for fast-food restaurant services and products in the menu of fast-food establishments, in a part of the territory of the European Union. In that regard, it referred in particular to the independent survey conducted in 1991 and 1992 and to the decisions of the national courts produced by the intervener.

49 In the present case, the applicant merely claims that the evidence produced by the intervener does not demonstrate that the actual use of the prefix ‘mc’, combined with another word, was sufficient, in the territory of the European Union, in the relevant periods, for that prefix to be associated, by the relevant public, to foodstuffs and beverages. Thus, the applicant does not dispute the actual use of the earlier marks, but the fact that that use was sufficient for the prefix ‘mc’, combined with another word, to acquire its own distinctive character for foodstuffs and beverages.

50 At the outset, it should be noted that, in paragraph 59 of the contested decision, the Board of Appeal merely found that the actual use of the prefix ‘mc’, combined with another word, had been, at least in part of the territory of the European Union, sufficient, in the relevant periods, for this

prefix to be associated by the relevant public, to fast-food restaurant services and the goods on the menu of fast-food establishments.

51 In the present case, it is therefore necessary to determine whether the intervener provided the evidence of actual use of the trade marks referred to in paragraphs 47 and 48 above, such as to have conferred on the prefix ‘mc’, combined with another word, its own distinctive character in relation to fast-food restaurant services and the products on the menu of fast-food establishments, at least in part of the territory of the European Union.

52 In that regard, it should be noted that, to assess whether a trade mark has been put to actual use in a specific case, an overall assessment of the evidence produced must be carried out, taking account of all the relevant factors in the case. In such an assessment, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see, by analogy, judgment of 29 February 2012 in *Certmedica International and Lehning entreprise v OHIM — Lehning entreprise and Certmedica International (L112)*, T-77/10 and T-78/10, not published, EU:T:2012:95, paragraph 40 and the case-law cited).

53 Actual use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence (see, by analogy, judgment of 23 September 2009 in *Cohausz v OHIM — Izquierdo Faces (acopat)*, T-409/07, not published, EU:T:2009:354, paragraph 36 and the case-law cited).

54 However, it follows from Rule 22(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), which applies *mutatis mutandis* in invalidity proceedings pursuant to Rule 40(6) of that regulation, that the evidence of use is, in principle, confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing sworn or affirmed, as referred to in Article 78(1)(f) of Regulation No 207/2009.

55 Furthermore, it follows from Article 57(2) of Regulation No 207/2009, read in conjunction with Article 42(2) of that regulation, that the periods to be taken into account to establish genuine use of the McDONALD’S trade mark and, *a fortiori*, actual use of the other earlier marks, deriving from that mark and that may constitute, according to the intervener, a ‘family’ of trade marks are, on the one hand, the period from 12 January 2004 to 11 January 2009 and, on the other, the period from 13 August 2005 to 12 August 2010 (‘the relevant periods’). Admittedly, taking into consideration circumstances that are subsequent to, or even prior to, the periods thus defined by the applicable legislation is possible, but is necessarily subject to the presentation of documents showing use of the trade marks concerned during those periods (see, by analogy, the judgment of 27 September 2012 in *El Corte Inglés v OHIM — Pucci International (PUCCI)*, T-39/10, not published, EU:T:2012:502, paragraph 26). The Board of Appeal was therefore right, in paragraph 86 of the contested decision, to endorse the findings set out in paragraph 24 of the decision of the Cancellation Division, which define the relevant periods in the manner referred to above.

56 The evidence of use produced in the present case by the intervener is listed in paragraphs 29 and 30 of the decision of the Cancellation Division.

57 As the Board of Appeal was right to state in paragraphs 57 and 86 of the contested decision, the evidence produced relating to the relevant periods prove to the requisite legal standard, at least in part of the territory of the European Union, the genuine use of the McDONALD'S trade mark for fast-food restaurant services. Indeed, that evidence shows that, during the relevant periods, the McDONALD'S trade mark has remained one of the 10 most important marks worldwide and that it has been used intensively, over a substantial part of the territory of the European Union, to designate fast-food services and products on the menu of fast-food establishments.

58 Furthermore, as the Board of Appeal correctly found in paragraph 58 of the contested decision and as is apparent, moreover, from the evidence produced by the intervener, the intervener had already obtained registration or registered, during the relevant periods, many marks combining the prefix 'mc' with another word, such as the trade marks McFISH, McTOAST, McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN, EGG McMUFFIN and McFEAST, for fast-food services and goods on the menu of fast-food establishments. Furthermore, it used the marks McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN in Germany and the marks McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN in the United Kingdom, to designate goods on the menu of fast-food establishments and on advertising material. Even if, as the applicant noted, the intervener did not provide information on the turnover achieved for each of the goods in question, it placed on the case-file relating to the proceedings before EUIPO documents which establish that, in 2004 and 2009, during the relevant periods, it had, respectively, 1 262 and 1 361 establishments in Germany and 1 250 and 1 193 establishments in the United Kingdom. Furthermore, it is apparent from the 2009 annual report drawn up by the intervener for Germany, produced during the proceedings before EUIPO and included in the file of the present proceedings, that the intervener's German establishments achieved a significant turnover in 2008 and 2009. Assessed globally, in accordance with the solution adopted in the judgment of 17 February 2011 in *J & F Participações v OHIM — Plusfood Wrexham (Friboi)* (T-324/09, not published, EU:T:2011:47, paragraphs 27 and 31), that evidence makes it possible to find, in the present case, actual use by the intervener of the marks McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN in Germany and in the United Kingdom, namely in a substantial part of the territory of the European Union, during the relevant periods.

59 Moreover, as correctly observed by the Board of Appeal in paragraph 59 of the contested decision, the courts in Germany, Spain, Sweden and the United Kingdom found, during the relevant periods, that the prefix 'mc', combined with another word, had acquired its own distinctive character for fast-food services and goods on the menu of fast-food establishments. While EUIPO is not bound by decisions made by the authorities in the Member States and while, in so far as the application of EU trademark law is independent of any national system, the legality of EUIPO decisions cannot be called into question solely on the basis of assessments contained in earlier national decisions, those decisions may nevertheless be taken into consideration by EUIPO, as indicia, in the context of its assessment of the facts of the case (see, to that effect, judgments of 21 April 2004 in *Concept v OHIM (ECA)*, T-127/02, EU:T:2004:110, paragraphs 70 and 71; of 9 July 2008 in *Reber v OHIM — Chocofabriken Lindt & Sprüngli (Mozart)*, T-304/06, EU:T:2008:268, paragraph 45; and of 25 October 2012 in *riha v OHIM — Lidl Stiftung (VITAL&FIT)*, T-552/10, not published, EU:T:2012:576, paragraph 66). Thus, contrary to what the applicant claims, the Board of Appeal could, for purposes of its own assessment of the facts of the case, take into account in the contested decision, as indicia, the findings made by the national courts during the relevant periods, from which it was clear that, in the territory covered by their competence, the use of the prefix 'mc', combined with another word, was such that it enabled it to acquire its own distinctive character for fast-food restaurant services and the goods on the menu of fast-food establishments.

60 As the Board of Appeal rightly pointed out in paragraph 59 of the contested decision, the findings thus made by the national courts were, furthermore, supported by the independent survey carried out in 1991 and 1992, from which it is apparent that, in the mind of the relevant public, the prefix ‘mc’ was largely associated with the sign McDONALD’S and that that prefix, combined with another word, was widely associated with fast-food establishments belonging to the same group. According to the case-law cited in paragraph 55 above, those elements, prior to the relevant periods, could be used by the Board of Appeal. As regards the questions raised in the independent survey, it should be noted, contrary to what the applicant claims, that their formulation made it possible to verify, objectively, to what extent, in the mind of the relevant public, namely the German consumer of fast-food services, the prefix ‘mc’ was associated, on the one hand, with the sign McDONALD’S and, on the other, with fast-food restaurant services belonging to the same group. As regards the specific time frame of those results, it must be held that they do not make it possible to make links between the use of the McDONALD’S trade mark and the earlier marks McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN, the actual use of which was found in paragraph 58 above. Those marks were, moreover, all registered after the period covered by the independent survey. However, those results support the fact that, at the time when those marks were used, the prefix ‘mc’, combined with another word, had already acquired its own distinctive character in relation to fast-food restaurant services. As EUIPO rightly observed, there is no reason to conclude, in the circumstances of this case, that the findings made in the context of the independent survey had been subsequently invalidated, since, as the Board of Appeal noted in paragraph 86 of the contested decision, the evidence produced by the intervener demonstrates that, during the relevant periods, the intervener continued to register trade marks combining the prefix ‘mc’ with another word and that the McDONALD’S trade mark has remained one of the most important trade marks in the world. That proves that the intervener continued to invest to preserve the reputation of that mark for fast-food restaurant services.

61 The evidence produced by the intervener therefore demonstrates that the use by the latter of the marks McDONALD’S, McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN was sufficient to ensure that, in the relevant periods, the prefix ‘mc’, combined with the name of a menu item or foodstuff, retains its own distinctive character that it had previously acquired in relation to fast-food restaurant services and goods on the menu of fast-food establishments, at least in part of the territory of the European Union.

62 Consequently, the Board of Appeal was right to find, in paragraph 60 of the contested decision, that the intervener had provided sufficient indications that the earlier marks, referred to in paragraph 58 above, had actually been used during the relevant periods.

63 In addition, the Board of Appeal was right to find, in essence, in paragraphs 67 to 69, 73 and 74 of the contested decision, that the evidence produced by the intervener demonstrated to the requisite legal standard that, during the relevant periods, the prefix ‘mc’ combined with the name of a menu item or foodstuff, had acquired its own distinctive character in relation to fast-food restaurant services and goods on the menu of fast-food establishments, at least in part of the territory of the European Union, so that, according to the case-law cited in paragraph 43 above, that prefix was capable of characterising the existence of a family of marks.

64 Finally, it should be noted that the marks McMUFFIN, McRIB, McFLURRY, CHICKEN McNUGGETS, McCHICKEN and EGG McMUFFIN, derived from the McDONALD’S trade mark, fulfil all the conditions to form a ‘family’ of trade marks, within the meaning of the case-law cited in paragraph 43 above, in so far as they are sufficient in number and reproduce in full the same distinctive element, namely the element ‘mc’, with the addition of a word element that differentiates them from each other and that they are characterised by the repetition of the same prefix, ‘mc’,

taken from the McDONALD'S trade mark. The fact that, in the latter mark, the second element refers to a surname whereas, in the marks constituting the family, it refers to the name of goods on the menu of fast-food establishments is irrelevant, contrary to what the applicant claims. As the Board of Appeal correctly observed in paragraph 81 of the contested decision, the McDONALD'S trade mark, with a reputation for fast-food restaurant services, is the original trade mark of the family, to which all the derived marks are connected by a common feature, namely the prefix 'mc', and from which they are all separated by the same type of final element, which refers to one of the foodstuffs on the menu of the intervener's fast-food restaurants, as is pointed out in paragraph 61 of the contested decision.

65 The Board of Appeal was also right to find, therefore, in paragraphs 58 and 60 of the contested decision, that the earlier marks formed a 'family of marks' and had been used 'as a "family of marks"'.

– The presence, in the contested mark, of elements capable of associating it with the 'Mc' family of trade marks

66 In paragraphs 63 and 64 of the contested decision, the Board of Appeal held that the contested mark had characteristics capable of associating it with the 'Mc' family of marks, in so far as (i) that mark began with the prefix 'mac', which would probably be perceived as being almost identical to the prefix common to the 'Mc' family of marks, (ii) the structure of the mark at issue was very similar to that which was common to the 'Mc' family of marks and (iii) the prefixes 'mc' and 'mac' occupied, in the contested mark and in the 'Mc' family of marks, the same position and had the same semantic content.

67 In that regard, it must be held that the Board of Appeal was right to find, in the circumstances of the present case, that the contested mark had characteristics capable of associating it with the 'Mc' family of marks, for the reasons stated in paragraphs 30 and 64 above.

68 The arguments put forward by the applicant to contest the existence of characteristics capable of associating the contested mark with 'Mc' family of marks are not convincing.

69 As regards the argument that the initial element of the contested mark, namely the element 'mac' is simply similar to the prefix common to the 'Mc' family of marks, namely the prefix 'mc', whereas Part C, 'Opposition', Section 2, Chapter 7, paragraph 2, p. 4 of the EUIPO directives provides that the element common to the contested mark and to the family of marks must be 'identical or very similar', it suffices to note that, at least for the part of the relevant public that knows the prefixes of Gaelic surnames, the initial element of that mark, namely the element 'mac', is perceived as identical or equivalent to the initial element common to the 'Mc' family of marks, namely the element 'mc'.

70 As regards, moreover, the arguments based on the visual comparison of the marks at issue, those are irrelevant in so far as it is the conceptual identity and, to a lesser extent, the phonetic identity of the initial elements of the contested mark and the 'Mc' family of marks, as well as the identical structure of the former and latter, which make it possible to associate the contested mark with that family of marks (see paragraph 69 above). In any event, the fact that, in their actual use, the contested mark and the earlier marks of that family of marks can be distinguished by the use of upper or lower case characters is irrelevant, according to the case-law already cited in paragraph 24 above.

71 Furthermore, the argument concerning the different structure of the contested mark and of the earlier marks of the ‘Mc’ family of marks, while relevant, cannot call into question the merits of the assessment of the Board of Appeal. The Board of Appeal was right to find, in paragraph 92 of the contested decision, that the goods for which the disputed mark was registered, and which covered both foodstuffs (including ice cream, muffins, filled sandwiches and toasted sandwiches) and beverages, were closely linked to services for which the McDONALD’S trade mark had a reputation, namely fast-food restaurant services, in the context of which foodstuffs and drinks were supplied to customers (see paragraph 76 et seq. below). Furthermore, in so far as the applicant states that it uses the contested mark only to market beverages, it should be noted that, according to the case-law, it is not the goods for which the mark at issue is actually used in the market that must be taken into account, but those goods for which the mark was registered (see, to that effect, judgment of 13 April 2005 in *Gillette v OHIM — Wilkinson Sword (RIGHT GUARD XTREME sport)*, T-286/03, not published, EU:T:2005:126, paragraph 33).

72 Finally, as regards the argument that the contested mark does not reproduce the same structure as that of the McDONALD’S trade mark, this is irrelevant. What matters is that the contested mark reproduces the common characteristics that connect the earlier marks of the ‘Mc’ family of marks and which differentiate them from the McDONALD’S trade mark, which is the original mark of that family of marks.

73 Ultimately, it should be noted that the Board of Appeal was justified, having regard to the case-law cited in paragraph 42 above, to consider, in paragraphs 99 and 100 of the contested decision, that the existence of the ‘Mc’ family of marks was, in the present case, a factor to be taken into account in assessing the establishment, on the part of the relevant public, of a link between the marks at issue.

On whether there is a certain degree of similarity between the goods and services at issue

74 The applicant submits that the Board of Appeal made an error of assessment, in the contested decision, in finding that there is a certain degree of similarity between the services and the goods at issue, by reason of the close links existing between them. According to the applicant, the services and goods at issue are, for the McDONALD’S trade mark, fast-food restaurant services, in respect of which that trade mark has a reputation, and, for the contested trade mark, the goods for which the latter was registered, namely certain foodstuffs and certain beverages and, in particular, coffee, artificial coffee, instant coffee, instant coffee mix, coffee beans, coffee in ground form in class 30 (‘basic coffee goods’) which are sold under the trade mark concerned. The applicant claims that it is clear from EUIPO’s decision-making practice that restaurant services, on the one hand, and foodstuffs and beverages, on the other hand, are not similar. The fact that consumers of the services and goods at issue are, it is claimed, the same is irrelevant for assessing whether there is a similarity between those services and those goods, since the general public within the European Union purchases all types of services and goods, which could be very similar or very different. Basic coffee goods, it is claimed, are not at all similar to fast-food restaurant services, as they are sold in supermarkets and grocery stores and not in fast-food restaurant establishments and, if they were, consumers would not believe that those establishments were responsible for their manufacture. The fact that the restaurant establishments use raw foodstuffs and serve foodstuffs does not mean that the restaurant services are similar to food foodstuffs, as is apparent both from the case-law and from Part C.2, Chapter 2.B, Section 5.3.3, of the EUIPO directives, as in force at the material time. According to the applicant, the case-law cited by EUIPO is irrelevant because it relates to prepared foods. The applicant considers that the documents placed by the intervener on the case-file relating to the proceedings before EUIPO did not enable the Board of Appeal to claim, in paragraph 101 of

the contested decision, that foodstuffs, such as ketchup, were sold under the McDONALD'S trade mark in German and Italian supermarkets

75 EUIPO and the intervener dispute the applicant's arguments and submit that the Board of Appeal did not make an error of assessment, in the contested decision, in finding that there is a certain degree of similarity between the services and the goods at issue.

76 At the outset, it should be recalled that Article 8(5) of Regulation No 207/2009 must be interpreted as meaning that it may be relied on in support of an application for a declaration of invalidity, whether the goods and services covered by the earlier European Union mark and the goods and services for which a European Union trade mark has been registered are identical or similar, or are neither identical nor similar (see, to that effect, judgment of 22 March 2007 in *Sigla v OHIM — Elleni Holding (VIPS)*, T-215/03, EU:T:2007:93, paragraph 33).

77 According to case-law, the degree of closeness or dissimilarity of the goods or services concerned is only, in that context, a relevant factor when assessing the establishment, on the part of the public concerned, of a link between the trade marks at issue (see judgment of 6 July 2012 in *ROYAL SHAKESPEARE*, T-60/10, not published, EU:T:2012:348, paragraph 21 and the case-law cited).

78 In assessing the similarity of the goods and services concerned, all the factors relating to those goods and services should be taken into account, including, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (judgment of 29 September 1998 in *Canon*, C-39/97, EU:C:1998:442, paragraph 23).

79 As was observed in paragraph 71 above, the goods and services to be compared in the present case are, first, the services for which the McDONALD'S trade mark has a reputation, namely fast-food restaurant services, in the context of which foodstuffs and drinks were supplied to customers and, secondly, the goods for which the contested mark is registered, which covers certain foodstuffs and beverages. For the reasons set out in paragraph 71 above, the applicant cannot validly claim that that comparison should focus, with regard to the contested mark, on drinks, in so far as, in practice, it uses that mark primarily to market drinks.

80 Admittedly, it is indisputable that foodstuffs and drinks, on the one hand, and restaurant services, on the other, do not have the same nature, the same intended purpose or the same method of use (see, to that effect, judgment of 12 December 2014 in *Comptoir d'Épicure v OHIM — A-Rosa Akademie (da rosa)*, T-405/13, not published, EU:T:2014:1072, paragraph 96). However, it follows from the case-law that foodstuffs, broadly speaking, including beverages, on the one hand, and restaurant services, on the other, have, despite their differences, a certain degree of similarity, since (i) the foodstuffs concerned are used and offered in the context of restaurant services, so that there is complementarity between those goods and services, (ii) the restaurant services can be offered in the same places as those in which the foodstuffs concerned are sold and (iii) the foodstuffs concerned may originate from the same undertakings or from economically-linked undertakings which market packaged goods, or from restaurants which sell ready-made food to take away (see, to that effect, judgments of 12 December 2014 in *da rosa*, T-405/13, not published, EU:T:2014:1072, paragraphs 97 and 98 and the case-law cited, and of 4 June 2015 in *Yoo Holdings v OHIM — Eckes-Granini Group (YOO)*, T-562/14, not published, EU:T:2015:363, paragraphs 25 to 28).

81 The fact that the EUIPO directives cited by the applicant do not reflect exactly, in that regard, the case-law cited in paragraph 80 above is irrelevant, since those directives are not binding legal acts for the purpose of interpreting provisions of EU law (judgment of 19 December 2012 in *Leno Merken*, C-149/11, EU:C:2012:816, paragraph 48).

82 In the present case, first of all, it should be noted that the foodstuffs, in the broad sense, covered by the contested mark may be used and offered in the context of the fast-food restaurant services provided by the intervener. Certain foodstuffs covered by the contested mark, such as ice cream, muffins, filled sandwiches and toasted sandwiches, are not, moreover, simple ingredients serving as the basis for dishes served in fast-food restaurants, but correspond to the goods offered, as such, on the menu of those establishments. Thus, as the Board of Appeal correctly observed in paragraph 95 of the contested decision, the foodstuffs and restaurant services in question are intended for the same consumers. There is, therefore, complementarity between those goods and services.

83 Secondly, as regards foodstuffs covered by the contested mark and corresponding to goods used or offered, as such, on the menu of fast-food establishments, it should be noted that those goods can be consumed on the spot, in the establishments themselves where the intervener's fast-food restaurant services are offered.

84 Finally, as the intervener has stated, fast-food restaurant services, such as those which it provides, are also provided on a take-away basis. In such a case, the consumer tends to establish a link between the mark affixed to the packaging of the take-away goods and the commercial origin of those goods.

85 In the light of the observations set out in paragraphs 82 to 84 above, it should be noted that the assessments of the Board of Appeal in paragraphs 92, 95, 96 and 101 of the contested decision, according to which there is a certain degree of similarity between the services and goods in question, because of the close links between them, are well-founded.

86 Since those grounds are sufficient to justify the contested decision, there is no need to examine the applicant's complaints against the superfluous ground set out in the second sentence of paragraph 102 of the contested decision, alleging that some of the intervener's goods (ketchup) are sold in supermarkets in Germany and Italy. The Board of Appeal therefore correctly concluded, *inter alia* in paragraph 102 of the contested decision, that the relevant public could establish a mental link between the marks at issue.

The risk of unfair advantage being taken from the reputation of the McDONALD'S trade mark by the use without due cause of the contested mark

87 At the outset, it should be recalled that the establishment, on the part of the public concerned, of a link between the trade marks involved constitutes a condition which is necessary but not, of itself, sufficient to establish the existence of one of the types of injury against which Article 8(5) of Regulation No 207/2009 ensures protection for the benefit of marks with a reputation (see judgment of 7 December 2010 in *Nute Partecipazioni and La Perla v OHIM — Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, T-59/08, EU:T:2010:500, paragraph 30 and the case-law cited).

88 In order to benefit from the protection introduced by Article 8(5) of Regulation No 207/2009, the proprietor of the earlier European Union mark must adduce proof that the use without due cause of the mark, in respect of which a declaration of invalidity is sought, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier European Union mark (see, by

analogy, judgment of 7 December 2010 in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraph 31 and the case-law cited).

89 Just one of those three types of injury suffices for Article 8(5) of Regulation No 207/2009 to apply (see, by analogy, judgment of 7 December 2010 in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraph 32 and the case-law cited) it being noted that both the Cancellation Division and the Board of Appeal, in the contested decision, confined themselves to holding that there was an injury consisting of taking unfair advantage of the repute of the McDONALD'S trade mark.

90 The applicant submits that the Board of Appeal made an error of assessment, in the contested decision, in finding that the applicant could take unfair advantage of the reputation of the McDONALD'S trade mark through use without due cause of the contested trade mark. It states that the contested decision is based on the incorrect finding of the reputation acquired by the prefix 'mc' of the McDONALD'S trade mark, combined with the name of a menu item or a foodstuff. In those circumstances, it would be wrong to claim that the contested mark, combining the prefix 'mac' with the word 'coffee', would be perceived by the relevant public as reproducing the structure of the McDONALD'S trade mark. According to the applicant, the Board of Appeal erred, in paragraph 99 of the contested decision, in finding that, in so far as it only affixed the contested mark on coffee and coffee packaging, there was no doubt that the applicant was seeking to reproduce, identically, the structure common to the 'Mc' family of trade marks. In that regard, the applicant states that, in the present proceedings, EUIPO and the intervener do not claim, moreover, that it chose the contested mark in bad faith. Furthermore, the intervener has not brought any infringement proceedings against it. The applicant submits that a statement which it placed on the file of the proceedings before EUIPO confirms that the contested mark was chosen in good faith and that use of the mark to sell coffee is explained by the fact that the element 'coffee' refers to those goods.

91 Finally, the applicant complains that the Board of Appeal did not take market realities into account even though, when the marks concerned are actually used in that market, the proprietor of the earlier European Union mark must provide evidence that the proprietor of the trade mark in respect of which a declaration of invalidity is sought actually takes unfair advantage of the reputation of its mark. The Board of Appeal, it is claimed, overlooked the fact that, in Bulgaria, Estonia, Cyprus, Latvia, Hungary and Poland, at least since 1994, the marks at issue have coexisted peacefully, even when, as in Poland, the use of the contested mark has been intensive. According to the applicant, it must be assumed that the reality of the market is the same throughout the European Union. However, the fact that the proprietor of the earlier trade marks has brought actions against the proprietor of the trade mark in respect of which a declaration of invalidity is sought is not, it is claimed, a factor which makes it possible to find, on the part of the relevant public, that there is confusion, the establishment of a link or an image transfer between those trade marks. The applicant claims that the intensive, prolonged, peaceful use made in good faith, alongside the McDONALD'S trade mark, with a reputation for fast-food restaurant services, of the contested trade mark covering basic coffee goods constitutes due cause for use of that latter trade mark, for the purposes of Article 8(5) of Regulation No 207/2009.

92 EUIPO and the intervener dispute the applicant's arguments and submit that the Board of Appeal did not make an error of assessment, in the contested decision, in concluding that the use without due cause of the trade mark contested by the applicant takes unfair advantage of the reputation of the McDONALD'S trade mark.

93 In that regard, it should be noted that the existence of injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is

the drawing of benefit from that mark by the proprietor of the later mark, must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect (see, by analogy, judgment of 27 November 2008 in *Intel Corporation*, C-252/07, EU:C:2008:655, paragraphs 35 and 36).

94 The existence of an ‘advantage [taken unfairly] of the repute of the earlier [European Union] trade mark’, within the meaning of Article 8(5) of Regulation No 207/2009, does not require that there be a likelihood of confusion or a likelihood of detriment to the repute of that mark or, more generally, to its proprietor (see, by analogy, judgment of 18 June 2009 in *L’Oréal and Others*, C-487/07, EU:C:2009:378, paragraph 50). This arises from the use by a third party of a mark similar to the earlier European Union mark where, by that use, that third party attempts to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation, the marketing effort made by the proprietor of the European Union mark in order to create and maintain the image of that mark (see, to that effect, judgments of 18 June 2009 in *L’Oréal and Others*, C-487/07, EU:C:2009:378, paragraph 50, and of 7 December 2010 in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraph 44 and the case-law cited).

95 In order to determine whether the use of the mark in respect of which a declaration of invalidity is sought takes unfair advantage of the distinctive character or the repute of the earlier European Union mark, it is necessary to make a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark’s reputation and the degree of distinctive character of the earlier European Union mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the earlier European Union mark, the stronger that mark’s distinctive character and reputation are, the easier it is to accept that detriment has been caused to it. Furthermore, the more immediately and strongly the European Union mark is brought to mind by the mark in respect of which a declaration of invalidity is sought, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the repute of the earlier European Union mark (see judgment of 7 December 2010 in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraph 42 and the case-law cited).

96 The proprietor of the earlier European Union mark is not required to demonstrate actual and present injury to its mark for the purposes of Article 8(5) of Regulation No 207/2009. When it is foreseeable that such injury will ensue from the use which the proprietor of the mark, in respect of which a declaration of invalidity is sought, may be led to make of its mark, the proprietor of the earlier European Union mark cannot be required to wait for this actually to occur in order to be able to prohibit that use. The proprietor of the earlier European Union mark must, however, prove that there is a serious risk that such an injury will occur in the future (see judgment of 7 December 2010, in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraphs 33 and 54 and the case-law cited).

97 Where the proprietor of the earlier European Union mark has shown that there is either actual and present injury to its mark or, failing that, a serious risk that such injury will occur in the future, it is for the proprietor of the mark, in respect of which a declaration of invalidity is sought, to establish that there is due cause for the use of that mark (see judgment of 7 December 2010 in *NIMEI LA PERLA MODERN CLASSIC*, T-59/08, EU:T:2010:500, paragraph 34 and the case-law cited).

98 In the light of the rules referred to in paragraphs 93 to 97 above, it is appropriate to consider the arguments of the parties directed against the grounds which led the Board of Appeal, in the contested decision, to endorse the findings of the Cancellation Division according to which the use without due cause of the contested mark unfairly took advantage of the repute of the McDONALD'S trade mark.

99 In the present case, the Board of Appeal concluded, in paragraph 90 of the contested decision, that the relevant public was the relevant public for the goods covered by the contested mark, namely the general public within the European Union, with an average level of attention. Furthermore, the Board of Appeal found, in paragraph 108 of the contested decision, that it was sufficiently established that the use without due cause of the contested mark took unfair advantage of the repute of the McDONALD'S trade mark. As is apparent in paragraphs 102 to 108 of that decision, it indeed felt it was highly likely that the contested mark rode on the coat-tails of the McDONALD'S trade mark, in order to benefit from its power of attraction, its reputation and its prestige, and exploited, without paying any financial compensation, the marketing effort made by the intervener in order to create and maintain the image of the McDONALD'S trade mark. According to the Board of Appeal, all the factors of the case made it possible to conclude that the relevant public or a substantial part of it, could establish a mental link between the marks at issue, in so far as, upon seeing the contested mark affixed to the goods closely linked to those of the intervener, it could be attracted by the fact that that mark had practically the same prefix and reproduced the same structure as the McDONALD'S trade mark and could associate that mark with the 'Mc' family of marks, of which the McDONALD'S trade mark was the original trade mark.

100 Therefore, the Board of Appeal concluded that the use of the contested mark could entail a transfer of the image of the McDONALD'S trade mark, or of the characteristics which it projects, to the goods covered by the contested mark. The relevant factors for its assessment were, as stated in paragraphs 99 to 101 of the contested decision (i) the considerable reputation of the McDONALD'S trade mark, (ii) the distinctive character acquired by the prefix 'mc', combined with the name of a menu item or foodstuff, for fast-food restaurant services and goods on the menu of fast-food establishments, (iii) the fact that the contested mark reproduced the same structure as 'Mc' family of marks and (iv) the fact that the goods and services in question had a certain degree of similarity, because of the close links between them.

101 As EUIPO rightly observes, the applicant does not dispute the assessment of the relevant public made by the Board of Appeal. Moreover, that definition is correct and must be upheld. The products covered by the contested mark are intended for the general public within the European Union, which has an average level of attention. Moreover, the McDONALD'S trade mark was registered on 16 July 1999, with a prior right on the 1st April 1996 and enjoyed, in the European Union, a considerable reputation for fast-food restaurant services which, furthermore, is not disputed by the applicant (see paragraph 16 above).

102 Regarding the applicant's complaint that the Board of Appeal could not, in the contested decision, make a finding of the reputation acquired by the prefix 'mc', combined with the name of a menu item or a foodstuff, for fast-food restaurant services and goods on the menu of fast-food establishments, it must be observed that this complaint was rejected in paragraph 63 above. The Board of Appeal was right to conclude that the considerable reputation of the McDONALD'S trade mark extended to the characteristic elements of the 'Mc' family of trade marks, without having to determine, as submitted by the applicant, whether each of the marks constituting that family was a mark with a reputation.

103 As regards the applicant's argument that it did not intend to reproduce the structure common to the 'Mc' family of marks in the contested mark, it was noted, in paragraph 67 above, that the Board of Appeal had rightly held, in paragraphs 61 and 99 of the contested decision, that the contested mark reproduced the 'Mc' family of marks. Whereas, for the reasons set out in paragraph 79 above, the Board of Appeal had no reason, in paragraph 99 of the contested decision, to rely on the argument that the applicant marketed, in practice, only coffee under the contested mark, nor to conclude from that that the contested mark sought to reproduce the 'Mc' family of marks, the fact remains that the error thus committed does not affect the legality of the contested decision. The grounds in question are superfluous in that decision and do not alter the conclusion, drawn in paragraph 61 of that decision, that the contested mark reproduces the structure common to the 'Mc' family of marks. The Board of Appeal was therefore right, in paragraph 99 of the contested decision, to find that the existence of a 'Mc' family of marks was a key factor to take into account when assessing whether there was an unfair advantage.

104 As regards the applicant's complaint alleging the absence of a close link between the goods and services in question, it should be recalled, as already noted in paragraph 83 above, that, in paragraphs 92, 95, 96 and 101 of the contested decision, the Board of Appeal correctly held that there was a certain degree of similarity between the goods and services in question, because of the close links between them.

105 According to the case-law cited in paragraph 95 above and in view of the conclusions drawn, in paragraph 73 above, as to the relevance of the factor relating to the existence of an 'Mc' family of marks, all of the factors considered by the Board of Appeal were relevant for an overall assessment of whether unfair advantage was taken of the reputation of the McDONALD'S trade mark through the use of the contested mark.

106 In an overall assessment of all those factors, the Board of Appeal, as already noted in paragraph 99 above, found that it was highly likely that the contested mark rode on the coat-tails of the McDONALD'S trade mark, due to the possible transfer, by the relevant public, of the image of the latter or of the characteristics which it projects, to the goods covered by the former.

107 As regards the applicant's complaint that the Board of Appeal did not take into account the reality of the market when making that assessment, it should be noted that the Board of Appeal only had to examine, in accordance with the case-law already cited in paragraph 96 above, whether the proprietor of the earlier European Union mark had adduced prima facie evidence of a future risk, which is not hypothetical, of unfair advantage. Such a conclusion could be established on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as any other circumstance of the case (judgment of 10 May 2012 in *Rubinstein and L'Oréal v OHIM*, C-100/11 P, EU:C:2012:285, paragraph 95).

108 As is apparent from paragraph 99 above, the Board of Appeal concluded, after an overall analysis of the relevant factors in the present case, that there was a serious risk that the relevant public would be able to associate the contested trade mark with the 'Mc' family of trade marks and establish a mental link between the marks at issue, so that there was a serious likelihood that use of the contested trade mark would take unfair advantage of the reputation of the McDONALD'S trade mark.

109 In so far as the applicant complains, inter alia, that the Board of Appeal did not take into account the fact that the marks at issue had peacefully coexisted in Bulgaria, Estonia, Cyprus, Latvia, Hungary and Poland, at least since 1994, its arguments must be rejected. The marks at issue cannot be regarded as being or having been in peaceful coexistence for the precise reason that the

intervener brought an application for cancellation of the contested mark, invoking the McDONALD'S trade mark. Furthermore, as that application was brought less than seven months after the registration of the contested mark, there could be no limitation in consequence of acquiescence, within the meaning of Article 54(1) of Regulation No 207/2009, in the present case. To the extent that, in the context of this complaint, the applicant invokes, in practice, the peaceful coexistence of the McDONALD'S trade mark, not with the contested mark, but with some of its national marks, identical to the contested mark, registered in Bulgaria, Estonia, Cyprus, Latvia, Hungary and Poland, at least since 1994, it should be noted, as the intervener correctly observed, that, even assuming that those marks have coexisted peacefully since the respective entry of the Member States concerned into the European Union, that does not demonstrate that that coexistence was general and related to all of the national marks, identical to the contested trade mark, registered by the applicant within the European Union. In the present case, the national decisions placed by the intervener on the case-file relating to the proceedings before EUIPO demonstrate, on the contrary, that the coexistence of the McDONALD'S trade mark and the applicant's national marks, identical to the contested mark, has not been 'peaceful' in Germany, Spain, Sweden and the United Kingdom, the applicant's national marks having been the subject of a number of disputes before the courts of those Member States (see, to that effect and by analogy, judgments of 3 September 2009, *Aceites del Sur-Coosur v Koipe*, C-498/07 P, EU:C:2009:503, paragraph 83, and of 8 December 2005 in *Castellblanch v OHIM — Champagne Roederer (CRISTAL CASTELLBLANCH)*, T-29/04, EU:T:2005:438, paragraph 74).

110 In any event, as the intervener correctly observes, the absence of a serious risk that the relevant public in the Member States in question would be able to associate certain other national marks of the applicant, identical to the contested mark, with the 'Mc' family of marks and establish a mental link between those national marks and the McDONALD'S mark cannot be inferred from the mere fact that the intervener did not oppose the registration of those national marks or apply for a declaration that they were invalid (see, to that effect and by analogy, as regards the existence of a likelihood of confusion, judgment of 11 May 2005 in *Grupo Sada v OHIM — Sadia (GRUPO SADA)*, T-31/03, EU:T:2005:169, paragraphs 85 and 86), even where there has been considerable use of those marks, as was the case, according to the applicant, in Poland.

111 There may be many reasons for this absence of a challenge, which are not necessarily related to the objective perception that the relevant public, in the Member States concerned, will have regarding the marks concerned. In the present case, the applicant did not provide any evidence that would rule out, in any event, that the general public in Bulgaria, Estonia, Cyprus, Latvia, Hungary or Poland would be able to associate the applicant's national marks, identical to the contested mark, with the 'Mc' family of marks and establish a mental link between those national marks and the McDONALD'S trade mark (see, to that effect and by analogy, judgment of 26 September 2012 in *CITIGATE*, T-301/09, not published, EU:T:2012:473, paragraph 128 and the case-law cited).

112 The complaint that the applicant makes, in essence, against the Board of Appeal for failing to find, in paragraphs 114 to 116 of the contested decision, that the applicant had due cause to use the contested mark, remains to be examined.

113 It follows from Article 8(5) of Regulation No 207/2009 that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith (see, to that effect and by analogy, judgment of 6 February 2014 in *Leidseplein Beheer and de Vries*, C-65/12, EU:C:2014:49, paragraph 60).

114 In the present case, in so far as the sign relied on by the applicant in the present complaint corresponds to the contested mark, it should be noted that the case-law cited in paragraph 113 above is not applicable, for two reasons. On the one hand, as the intervener correctly observes, the contested mark has not been used before the McDONALD'S trade mark, the latter having been registered before the contested mark. Furthermore, as already noted in paragraph 109 above, it cannot be held that the marks at issue have coexisted peacefully precisely because the intervener defended its rights in the McDONALD'S trade mark by bringing an application for a declaration of invalidity of the contested trade mark within the required time limits.

115 In so far as the signs relied on by the applicant in this complaint correspond to national marks, identical to the contested mark, that it registered in Bulgaria, Estonia, Cyprus, Latvia, Hungary and Poland, at least since 1994, it should be noted that, even assuming that those marks have coexisted peacefully with the McDONALD'S trade mark in the national markets concerned, that does not mean, as noted in paragraph 109 above, that the applicant tolerates or should tolerate the use of the contested mark throughout the European Union market.

116 The Board of Appeal therefore correctly found, in paragraphs 114 to 116 of the contested decision, that the applicant did not have just cause to use the contested mark.

117 Since none of the complaints raised by the applicant have been upheld, the present action must be dismissed in its entirety.

Costs

118 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

119 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (First Chamber),

hereby:

1. **Dismisses the action.**
2. **Orders Future Enterprises Pte Ltd to pay the costs.**

Kanninen

Pelikánová

Buttigieg

Delivered in open court in Luxembourg on 5 July 2016.

[Signatures]

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